

### **REMARKS**

Claims 1-33 are pending in the application. Claims 1-27 stand rejected and claims 28-33 remain withdrawn from consideration. By the above amendment, claim 1 has been amended, claims 2 and 25-33 have been canceled without prejudice, and new claims 34, 35, 36 and 37 have been added. No new matter has been introduced by virtue of the above claim amendments. The Examiner's reconsideration of the claim rejections is requested in view of the following remarks.

#### **Election/Restrictions**

The Final Office Action does not respond to Applicant's request for reconsideration of the claim restrictions as set forth in the previous Amendment, and it appears that the restriction requirements have been maintained. Accordingly, by the above amendment, Applicant has canceled claims 28-33.

#### **Claim Rejections Under 35 U.S.C. § 103**

The following obviousness rejections are asserted in the Final Office Action:

(i) Claims 1, 2, 6-9, 10-16, 18, 21-24 and 25 stand rejected as being anticipated by U.S. Patent No. 5,903,878 to Talati, et al. in view of U.S. Publication No. 2004/0260653 to Tsuei et al.;

(ii) Claims 3-5, 19 and 20 stand rejected as being unpatentable over Talati in view of Tsuei, as applied to claims 1 and 18, and further in view of U.S. Publication No. 2001/0037464 to Persels, et al.;

(iii) Claim 17 stands rejected as being unpatentable over Talati and Tsuei as applied to claim 1, and further in view of U.S. Publication No. 2003/0018572 to Beschle, et al.; and

(iv) Claims 26 and 27 stand rejected as being unpatentable over Talati and Tsuei as applied to claim 25 above, and further in view of U.S. Publication No. 2001/004050 to Fletcher et al.

At the outset, it is to be noted that the above rejections (i) and (iv) with respect to canceled claims 25-27 are moot.

It is respectfully that at the very least, the combination of Tsuei and Talati does not establish a *prima facie* case of obviousness against claims 1 and 18. Indeed, the combination of Tsuei and Talati does not teach or suggest the inventions of claims 1 or 18, as a whole.

The claimed inventions are generally directed to methods for confirming electronic transactions, wherein an electronic transaction between a first party (e.g., consumer) and second party (e.g., merchant) can be confirmed by *sending a confirmation message to a private mailbox location of the first party which is not disclosed to the second party during the transaction*. In the claimed inventions, the *first party provides the second party contact information of a third party service provider that has knowledge of a private mailbox associated with the first party*. The second party can send a request for confirmation of the electronic transaction to the private mailbox of the first party (Claim 1) or the third-party can send the request for confirmation to the private mailbox on behalf of the second party (claim 18). The first party will send a reply message to the request for confirmation to thereby confirm authorization of the electronic transaction.

In the Final Office Action, it is acknowledged that Talati does not disclose *wherein information regarding the private mailbox is not communicated to the second party during the electronic transaction*, as essentially recited in claims 1 and 18. However, the

Examiner relies on Tsuei paragraph [0026], lines 1-5, which teaches that a purchaser has his/her product shipped to a business or residence address *without having to reveal the business or residence address to the shipper or merchant*. It is respectfully submitted that Examiner's reliance on Tsuei in this regard is misplaced.

Indeed, in the claimed inventions, the private mailbox (associated with the first party) is a location to which a request is sent to the first party to confirm the electronic transaction, whereby the user can confirm the electronic transaction by sending a reply message to the confirmation request. Tsuei's teaching of *maintaining the privacy of a purchaser's mailing address to which packages are sent to the purchaser* is fundamentally different from, and unrelated to, the claimed inventions wherein the private mailbox is used to confirm the transaction. Indeed, the cited passage of Tsuei does *not* teach or suggest a private mailbox to which confirmation messages are sent to the first party to confirm the transaction, as currently claimed.

In the Final Office Action (page 3), it is contended that the motivation for combining Talati and Tsuei is that "*it reduces or eliminates fraud by protecting the identity of consumers when a transaction include shipping or mailing to consumers ...*" This statement actually underscores the impropriety of the proposed combination. **Tsuei's teaching of maintaining the privacy of the location of the purchaser's delivery address simply has nothing to do with using a private mailbox for confirming authorization of an electronic transaction**, as claimed in claims 1 and 18. Indeed, the basis for motivation provided by the Examiner is simply irrelevant to the claimed inventions, and does not provide sufficient legal support for the proposed combination.

For at least the above reasons, it is respectfully submitted that the combination of Tsuei and Talati does not establish a *prima facie* case of obviousness against claims 1 and 18.

Moreover, the remaining claims, which depend from claims 1 and 18, are patentable over the above cited combinations of references for at least the same reasons given for respective base claims 1 or 18. Withdrawal of the obvious rejections is requested.

Respectfully submitted,



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